



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

PATENT  
021227-000410US

Assistant Commissioner for Patents  
Washington, D.C. 20231

On

*September 24, 2004*

TOWNSEND and TOWNSEND and CREW LLP

By:

*[Signature]*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

DAIFUKU et al.

Application No.: 10/816,161

Filed: March 31, 2004

For: PRODRUGS OF HETEROARYL  
COMPOUNDS

Examiner: Not yet assigned

Art Unit: 1614

PETITION UNDER 37 CFR §1.47(a)

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Pursuant to 37 CFR §1.47(a), Applicants hereby petition for filing of the above-identified patent application when a joint inventor refuses to join in an application for patent. Proof of the pertinent facts is submitted herein with the petition, to properly establish that joint inventors Dr. Richard Daifuku and Dr. Alexander Gall refuse to join in the above-identified patent application. Specifically, Applicants are submitting the following items:

Exhibit A: a photocopy of the letter (dated June 30, 2004) accompanying a Declaration for Application and an Assignment of Patent Application (to Koronis Pharmaceuticals) that were mailed to Dr. Daifuku;

Exhibit B: a photocopy of a Certified Mail receipt (dated July 1, 2004), accompanying the letter of Exhibit A indicating the attempt to deliver the Declaration and Assignment for Dr. Daifuku's signature.

Exhibit C: a photocopy of a Certified Mail Return receipt (dated July 10, 2004) indicating that Dr. Daifuku received the letter of Exhibit A, the Declaration and Assignment for his signature;

Exhibit D: a photocopy of the letter (dated June 30, 2004) accompanying a Declaration for Application and an Assignment of Patent Application (to Koronis Pharmaceuticals) that were mailed to Dr. Gall;

Exhibit E: a photocopy of a Certified Mail receipt (dated July 1, 2004), accompanying the letter of Exhibit D indicating the attempt to deliver the Declaration and Assignment for Dr. Gall's signature; and

Exhibit F: a photocopy of a Certified Mail Return receipt (dated July 8, 2004) indicating that Dr. Gall received the letter of Exhibit D, the Declaration and Assignment for his signature.

Dr. Daifuku's last known address is: 9270 SE 36th Place, Mercer Island, WA 98040. Dr. Gall's last known address is: 20051 170th Avenue N.E., Woodinville, WA 98072. Applicant's attorney has reached Dr. Daifuku and Dr. Gall at their respective addresses, as shown by the return postcards from the post office, indicating that Dr. Daifuku and Dr. Gall each retrieved their July 1, 2004 certified letters from the post office. As more than two months have passed since Applicant's attorney received return postcards indicating that Dr. Daifuku and Dr. Gall each received correspondence including an executable declaration in the present application, Applicants submit that Dr. Daifuku and Dr. Gall refuse to join in the above-identified patent application.

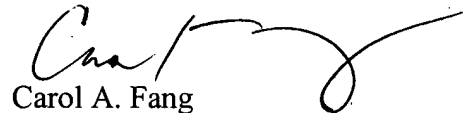
The other joint inventors, Dr. Sergueev, Dr. Sologub, and Dr. Harris, have executed the Declaration for Application (enclosed). Because Dr. Daifuku and Dr. Gall refuse to join in the above-identified patent application, Applicants request that the above-identified application be filed on behalf of Dr. Sergueev, Dr. Sologub, and Dr.

Harris and the nonsigning joint inventors, Dr. Daifuku and Dr. Gall, in accordance with 37 CFR §1.47(a).

Pursuant to 37 CFR §1.47(a), Applicants also submit herewith a response to the Notice of Missing Parts mailed June 14, 2004 including an executed Declaration by Dr. Sergueev, Dr. Sologub, and Dr. Harris, a petition to extend the period of response to the Notice to October 14, 2004, and authorization to charge the declaration surcharge to Deposit Account 20-1430.

Please charge \$130.00 for filing this petition to Deposit Account 20-1430. The Commissioner is hereby authorized to charge any additional fees associated with this petition or credit any overpayment to the Deposit Account identified above.

Respectfully submitted,



Carol A. Fang  
Reg. No. 48,631

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: (415) 576-0200  
Fax: (415) 576-0300  
ASP:caf  
60314688 v1

TOWNSEND  
and  
TOWNSEND  
and  
CREW

LLP



Palo Alto, California  
Tel 650 326-2400

Walnut Creek, California  
Tel 925 472-5000

San Diego, California  
Tel 858-350-6100

Denver, Colorado  
Tel 303 571-4000

Seattle, Washington  
Tel 206 467-9600

**San Francisco**

Two Embarcadero Center  
8th Floor  
San Francisco  
California 94111-3834  
Tel 415 576-0200  
Fax 415 576-0300

June 30, 2004

***VIA CERTIFIED MAIL, RETURN RECEIPT REQUESTED***

Richard Daifuku  
9270 SE 36th Place  
Mercer Island, WA 98040

Re: US Patent Application No. 10/816,161  
For: PRODRUGS OF HETEROARYL COMPOUNDS  
Filed: March 31, 2004  
Our File No.: 021227-000410US

Dear Dr. Daifuku:

Attached are a Declaration and an Assignment for the above-referenced application. Please execute both documents and return them to us in the enclosed self-addressed stamped envelope. The due date for submitting these documents to the Patent Office is **August 14, 2004**.

We have also enclosed a copy of the application as filed.

Thank you for your kind attention to this matter.

Very truly yours,

  
Annette S. Parent

ASP/kk

Enclosures

cc: John M. Reno  
60251398 v1

Exhibit A

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN  
APPLICATION DATA SHEET (37 CFR 1.76)**

**Title of Invention** | **PRODRUGS OF HETEROARYL COMPOUNDS**

As the below named inventor(s), I/we declare that:

This declaration is directed to:

- ☐ The attached application, or
- ☒ Application No. 10/816,161, filed on March 31, 2004,
- ☐ as amended on \_\_\_\_\_ (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

All statements made herein of my/our own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

**FULL NAME OF INVENTOR(S)**

Inventor 1 Richard Daifuku Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: Russian Federation

Inventor 2 Alexander Gall Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: United States

Inventor 3 Dmitri Sergueev Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: Russian Federation

Inventor 4 Dina Sologub Date: \_\_\_\_\_

Signature: \_\_\_\_\_ Citizen of: United States

☒ Additional inventors are being named on 1 additional form(s) attached hereto.

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION  
USING AN APPLICATION DATA SHEET (37 CFR 1.76) –  
ADDITIONAL INVENTOR(S)  
Supplemental Sheet  
(Total of 2 sheets are submitted.)**

**FULL NAME OF INVENTOR(S)**

Inventor 5: Kevin Harris

Date:

Signature:

Citizen of: United States

Inventor 6:

Date:

Signature:

Citizen of:

Inventor 7:

Date:

Signature:

Citizen of:

Inventor 8:

Date:

Signature:

Citizen of:

**ASSIGNMENT OF PATENT APPLICATION**

**JOINT**

WHEREAS, Richard Daifuku of 9270 SE 36th Place, Mercer Island, WA 98040; Alexander Gall of 20051 170th Avenue, N.E., Woodinville, WA 98072; Dmitri Sergueev of 8747 N.E. 144th Court, Bothell, WA 98011; Dina Sologub of 12428 84th Avenue, N.E., Kirkland, WA 98034; Kevin Harris of 14702 107th Avenue, N.E., Bothell, WA 98011 hereinafter referred to as "Assignors," are the inventors of the invention described and set forth in the below-identified application for United States Letters Patent:

Title of Invention: PRODRUGS OF HETEROARYL COMPOUNDS

Date(s) of execution of Declaration:

Filing Date: March 31, 2004

Application No.: 10/816,161; and

WHEREAS, Koronis Pharmaceuticals, Incorporated, a corporation of the United States, located at 12277 134th Court N.E., Suite 110, Redmond, WA 98052-2431, hereinafter referred to as "ASSIGNEE," is desirous of acquiring an interest in the invention and application and in any U.S. Letters Patent and Registrations which may be granted on the same;

For good and valuable consideration, receipt of which is hereby acknowledged by Assignors, Assignors have assigned, and by these presents do assign to Assignee all right, title and interest in and to the invention and application and to all foreign counterparts (including patent, utility model and industrial designs), and in and to any Letters Patent and Registrations which may hereafter be granted on the same in the United States and all countries throughout the world, and to claim the priority from the application as provided by the Paris Convention. The right, title and interest is to be held and enjoyed by Assignee and Assignee's successors and assigns as fully and exclusively as it would have been held and enjoyed by Assignors had this Assignment not been made, for the full term of any Letters Patent and Registrations which may be granted thereon, or of any division, renewal, continuation in whole or in part, substitution, conversion, reissue, prolongation or extension thereof.

Assignors further agree that they will, without charge to Assignee, but at Assignee's expense, (a) cooperate with Assignee in the prosecution of U.S. Patent applications and foreign counterparts on the invention and any improvements, (b) execute, verify, acknowledge and deliver all such further papers, including patent applications and instruments of transfer, and (c) perform such other acts as Assignee lawfully may request to obtain or maintain Letters Patent and Registrations for the invention and improvements in any and all countries, and to vest title thereto in Assignee, or Assignee's successors and assigns.

Assignors hereby authorize and request Townsend and Townsend and Crew LLP, Two Embarcadero Center, Eighth Floor, San Francisco, CA 94111-3834, to insert herein above the application number and filing date of said application when known.

IN TESTIMONY WHEREOF, Assignors have signed their names on the dates indicated.

Dated: \_\_\_\_\_

\_\_\_\_\_  
Richard Daifuku

Witnessed:

by \_\_\_\_\_

by \_\_\_\_\_

Dated: \_\_\_\_\_

\_\_\_\_\_  
Alexander Gall

Witnessed:

by \_\_\_\_\_

by \_\_\_\_\_

Dated: \_\_\_\_\_

\_\_\_\_\_  
Dmitri Sergueev

Witnessed:

by \_\_\_\_\_

by \_\_\_\_\_

Dated: \_\_\_\_\_

\_\_\_\_\_  
Dina Sologub

Witnessed:

by \_\_\_\_\_

by \_\_\_\_\_

Dated: \_\_\_\_\_

\_\_\_\_\_  
Kevin Harris

Witnessed:

by \_\_\_\_\_

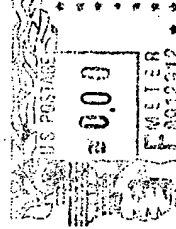
by \_\_\_\_\_



021227-000410US

U.S. Postal Service  
CERTIFIED MAIL RECEIPT  
(Domestic Mail Only; No Insurance Coverage Provided)

OFFICIAL USE



Sent To Richard Dai-foku 021227-000410US  
Street, Apt. No., or PO Box No. 9270 SE 36th place AS94W  
City, State, ZIP+4 Mercer Island WA 98040  
PS Form 3800, May 2000 See Reverse for Instructions

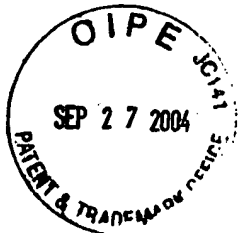
7000 1670 0007 7916 9877

BEST AVAILABLE COPY

021227-00041005

SENDER: COMPLETE THIS SECTION		COMPLETE THIS SECTION ON DELIVERY	
<ul style="list-style-type: none"><li>■ Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.</li><li>■ Print your name and address on the reverse so that we can return the card to you.</li><li>■ Attach this card to the back of the mailpiece, or on the front if space permits.</li></ul>		A. Received by (Please Print Clearly) <i>R. DAIFUKU</i>	B. Date of Delivery <i>7/10/04</i>
1. Article Addressed to:  <i>Richard Daifuku 9270 SE 36th Place Mercer Island, WA 98040</i>		C. Signature <i>X</i> <i>[Signature]</i>	<input type="checkbox"/> Agent <input type="checkbox"/> Addressee
		D. Is delivery address different from item 1? <input type="checkbox"/> Yes If YES, enter delivery address below: <input type="checkbox"/> No	
2. Article Number (Copy from service label) <i>7000 1670 0007 7916 9877</i>		3. Service Type <input checked="" type="checkbox"/> Certified Mail <input type="checkbox"/> Express Mail <input type="checkbox"/> Registered <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> Insured Mail <input type="checkbox"/> C.O.D.	
		4. Restricted Delivery? (Extra Fee) <input type="checkbox"/> Yes	
PS Form 3811, July 1999 Domestic Return Receipt 102595-00-M-0952			

TOWNSEND  
and  
TOWNSEND  
and  
CREW



Palo Alto, California  
Tel 650 326-2400

Walnut Creek, California  
Tel 925 472-5000

San Diego, California  
Tel 858-350-6100

Denver, Colorado  
Tel 303 571-4000

Seattle, Washington  
Tel 206 467-9600

**San Francisco**

Two Embarcadero Center  
8th Floor  
San Francisco  
California 94111-3834  
Tel 415 576-0300  
Fax 415 576-0300

June 30, 2004

***VIA CERTIFIED MAIL, RETURN RECEIPT REQUESTED***

Alexander Gall  
20051 170th Avenue, N.E.  
Woodinville, WA 98072

Re: US Patent Application No. 10/816,161  
For: PRODRUGS OF HETEROARYL COMPOUNDS  
Filed: March 31, 2004  
Our File No.: 021227-000410US

Dear Dr. Gall:

Attached are a Declaration and an Assignment for the above-referenced application. Please execute both documents and return them to us in the enclosed self-addressed stamped envelope. The due date for submitting these documents to the Patent Office is **August 14, 2004**.

We have also enclosed a copy of the application as filed.

Thank you for your kind attention to this matter.

Very truly yours,

Annette S. Parent

ASP/kk

Enclosures

cc: John M. Reno  
60251411 v1

Exhibit D

BEST AVAILABLE COPY

021227-00041005

SENDER: COMPLETE THIS SECTION		COMPLETE THIS SECTION ON DELIVERY	
<ul style="list-style-type: none"><li>■ Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.</li><li>■ Print your name and address on the reverse so that we can return the card to you.</li><li>■ Attach this card to the back of the mailpiece, or on the front if space permits.</li></ul>		<p>A. Received by (Please Print Clearly) <u>Anna Gall</u> B. Date of Delivery <u>7/8/04</u></p> <p>C. Signature <u>[Signature]</u> <input type="checkbox"/> Agent <input type="checkbox"/> Addressee</p> <p>D. Is delivery address different from item 1? <input type="checkbox"/> Yes If YES, enter delivery address below: <input type="checkbox"/> No <u>1</u></p>	
1. Article Addressed to:  <u>Alexander Gall</u> <u>20051 170th Avenue NE</u> <u>Woodinville, WA 98072</u>		3. Service Type <input checked="" type="checkbox"/> Certified Mail <input type="checkbox"/> Express Mail <input type="checkbox"/> Registered <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> Insured Mail <input type="checkbox"/> C.O.D.	
2. Article Number (Copy from service label) <u>7000 11670 0007 7916 9860</u>		4. Restricted Delivery? (Extra Fee) <input type="checkbox"/> Yes	

PS Form 3811, July 1999 Domestic Return Receipt 102595-00-M-0952


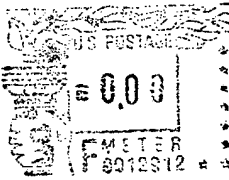
Exhibit F

BEST AVAILABLE COPY

7000 1670 0007 7916 9860

**U.S. Postal Service**  
**CERTIFIED MAIL RECEIPT**  
(Domestic Mail Only; No Insurance Coverage Provided)

**OFFICIAL USE**

Sent To Alexander Gall 021077-00041005  
Street, Apt. No., or PO Box No. 20051 170th Avenue NE Asplink  
City, State, ZIP+4 Woodinville WA 98072

PS Form 3800, May 2000 See Reverse for Instructions

Exhibit E